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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,916	11/13/2003	Upvan Narang	CMED.10092	7324

45473 7590 11/26/2007

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EXAMINER	
SILVERMAN, ERIC E	

ART UNIT	PAPER NUMBER
1615	

MAIL DATE	DELIVERY MODE
11/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/705,916	NARANG ET AL.	
	Examiner	Art Unit	
	Eric E. Silverman, PhD	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 October 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *25-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *25-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Applicants' response, filed 10/9/2007 has been received. Claims 25 – 34 are pending.

Information Disclosure Statement

Applicants' response included various references, but did not include an Information Disclosure Statement listing the references as required. At least because of this defect, the references have not been considered.

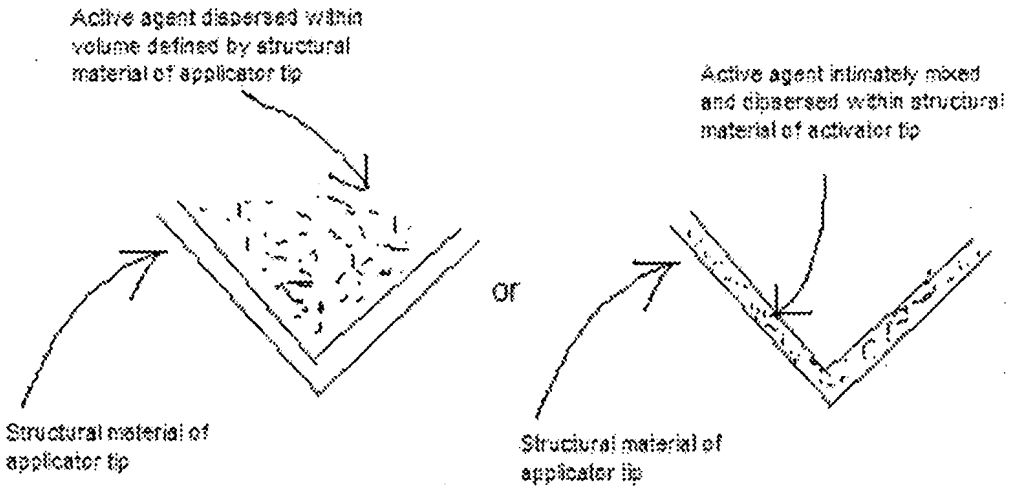
Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25 – 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 recites "at least one active member is substantially uniformly dispersed within the structural material of said applicator tip". It is not clear what is meant by this term. First, "substantially" is a term of degree, for which no reference is given. Second, it is not clear if the active member must be dispersed within the structural material in the sense that the active is intimately mixed with the structural material in a substantially uniform fashion, or if the active member must be dispersed within the structural material in the sense that the active is present inside a volume defined by the applicator tip's structural material. The cartoon below indicates the two possibilities.



Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The provisional rejection of claims 25 - 34 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 25 and 76 - 102 of copending Application No. 11/119,992 is **withdrawn** in view of the cancellation of the copending claims. However claims 25 – 34 are **now provisionally rejected** over added claims 145 – 163 of the '992 application. Although the conflicting claims are not identical, they are not patentably distinct from each other because while instant claims recite a product-by-process, copending claims recite a commensurate process and products made thereby. Because the processes appear to have the same or corresponding steps, it is understood that the product of instant claims is the result of performing copending method steps

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 25 – 34 **remain** rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4 - 35 of U.S. Patent No. 6,637,967.

Response to Arguments

Applicants argue that patented claims do not require that the active member be substantially uniformly dispersed within the structural material of the applicator tip. In response, this is understood to be a recitation of an inherent feature of patented claims.

Claims 25 – 34 **remain** rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 20 of U.S. Patent No. 5,928,611.

Response to Arguments

Applicants argue that patented claims do not require that the active member be substantially uniformly dispersed within the structural material of the applicator tip. In response, this is understood to be a recitation of an inherent feature of patented claims.

Claims 25 – 34 **remain** rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 31 of U.S. Patent No. 6,595,940.

Response to Arguments

Applicants argue that patented claims do not require that the active member be substantially uniformly dispersed within the structural material of the applicator tip. In response, this is understood to be a recitation of an inherent feature of patented claims.

Claims 25 – 34 **remain** rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 29 of U.S. Patent No. 6,779,657.

Response to Arguments

Applicants argue that patented claims do not require that the active member be substantially uniformly dispersed within the structural material of the applicator tip. In response, this is understood to be a recitation of an inherent feature of patented claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of claim 28 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is **withdrawn** in view of amendment.

Claim Rejections - 35 USC § 102

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24 – 35 **remain** rejected under 35 U.S.C. 102(b) as being anticipated by WO 96/40797, and under 35 U.S.C. 12(a) as being anticipated by US 5,928,611 to Leung.

The US Patent is continuation of the WO document, and the two therefore have the same disclosure. In the discussion below, reference is made to the WO document, with the understanding that the same teaching are present in the US patent.

Response to Arguments

Applicants' arguments have been fully considered, but are not persuasive.

Applicants argue that the prior art does not teach the active member being substantially uniformly dispersed in the structural material. In response, it is noted that in the examples of WO, the active material (initiators) is homogenously dispersed in acetone, and the porous applicator tips are soaked in the initiator solution to uptake the active. It is understood that the applicator tip will have substantially uniform porosity, and as such, the resulting material will inherently have a substantially uniform distribution of active. Because the WO reference inherently possesses the properties

that Applicants believe distinguish the instant claims, the arguments are not persuasive and the rejection is properly maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric E. Silverman, PhD whose telephone number is 571 272 5549. The examiner can normally be reached on Monday to Friday 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571 272 8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Art Unit 1615

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